THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

---

Ex parte SERGE M. TAVERNIER, ROBERT F. JANSSENS, LEO B. ALAERTS and HANS K. VAN CAUWENBERGHE

---

Appeal No. 96-3803
Application No. 08/128,245

---

HEARD: February 10, 2000

---

Before KIMLIN, JOHN D. SMITH, and GARRIS, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

This is an appeal from the final rejection of claims 10-17, all the claims remaining in the present application. A copy of illustrative claim 10 is appended to this decision.

In the rejection of the appealed claims, the examiner relies upon the following references:

| | | |
|---|---|---|
| Imai et al. (Imai) | 4,741,984 | May 03, 1988 |
| Aita | 4,868,085 | Sep. 19, 1989 |

| | | |
|---|---|---|
| Hikake et al. (Hikake) | 5,066,558 | Nov. 19, 1991 |
| Inoue et al. Inoue) | 5,077,169 | Dec, 31, 1991 |
| Konishirouku Photo | JP 62-289851 | Dec. 16, 1987 |

Appellants' claimed invention is directed to a dry electro-statographic developer composition comprising a toner which comprises inorganic microparticles, such as fumed silica, that have certain recited characteristics. In particular, the arithmetic product of the microparticles' BET surface (A) and methanol value (B) is greater than 10,000. Also, the ratio of the apparent density over the bulk density of the toner composition is greater than or equal to 0.2. According to appellants, the dry developer composition of the present invention exhibits "superior performance over the prior art dry developer compositions using such toner particles in terms of overall quality of the final electrostatographic print, and in terms of overall performance in the electrostatographic process" (page 4 of principal brief).

Appealed claims 10-17 stand rejected under 35 U.S.C. § 102(b) as being anticipated by either Imai or Aita. Also, the appealed claims stand rejected under 35 U.S.C. § 102(e) as being anticipated by either Hikake or Inoue. In addition, claims 10-17 stand rejected under 35 U.S.C. § 103 as being unpatentable over Imai, Aita, Hikake or Inoue in view of Konishiroku.

Upon careful consideration of the opposing arguments presented on appeal, we will not sustain the examiner's rejections.

We consider first the examiner's rejection of claims 10-17 under § 102 over either of Imai, Aita, Hikake or Inoue. While each of the references discloses a developer composition comprising inorganic microparticles having a particle size diameter less than about 10 microns, the examiner recognizes that none of the references discloses the claimed BET surface area, methanol value or the ratio of apparent density/bulk density. However, since the references disclose the same material for the inorganic microparticles as taught by

appellants in the present specification, *viz,* commercially available AEROSOL and CAB-O-SIL, the examiner reasons that the toner composition comprising the inorganic microparticles disclosed by each of the references "is identical to the instant claimed toner" (page 4 of answer). According to the examiner, "[i]t is inherent that when the two compositions are identical they have the same properties" (page 4 of answer).

It is, of course, well-settled law that when a claimed product reasonably appears to be substantially the same as a product disclosed by the prior art, the burden is on the applicant to prove that the prior art product does not necessarily or inherently possess characteristics attributed to the claimed product. In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). However, before the burden of proving a patentable distinction is placed on the applicant, the examiner has the initial burden of demonstrating a substantial correspondence between the prior art product and the claimed product such that one of ordinary skill in the art

would reasonably believe that the prior art and claimed products share the same properties. Here, we are not satisfied that the examiner has drawn the requisite correspondence between the claimed product and the prior art product.

The sole correspondence established by the examiner between the prior art products and the claimed product is that commercially-available AEROSIL and CAB-O-SIL is used for the inorganic microparticles. However, as demonstrated at pages 15-17 of appellants' specification, including TABLE II, a variety of types of fumed silica microparticles can be employed that have

different properties regarding BET surface and methanol value.

Specification TABLE II demonstrates that microparticles having properties within the claimed ranges produce better resolution than toner compositions comprising microparticles having BET surface and methanol values outside the claimed ranges.

Hence, simply stated, appellants' specification data demonstrates that one of ordinary skill in the art may formulate developer compositions comprising AEROSIL and CAB-O-SIL of the applied references and not inherently or necessarily obtain developer compositions within the scope of the appealed claims.

Turning to the examiner's § 103 rejection of the appealed claims over Imai, Aita, Hikake or Inoue in view of Konishiroku, Konishiroku's disclosure of the claimed apparent density/bulk density ratio does not remedy the basic deficiency of the primary references discussed above. The examiner's § 103 rejection is erroneously based on the presumption that the inorganic microparticles of the primary references inherently exhibit appellants' claimed BET surface and methanol value.

In conclusion, based on the foregoing, the examiner's decision rejecting the appealed claims is reversed.

REVERSED

| | | |
|---|---|---|
| EDWARD C. KIMLIN<br>Administrative Patent Judge | ) | |
| JOHN D. SMITH<br>Administrative Patent Judge | ) | BOARD OF PATENT APPEALS AND INTERFERENCES |
| BRADLEY R. GARRIS<br>Administrative Patent Judge | ) | |

vsh

Breiner & Breiner
P.O. Box 19290
Alexandria, VA 22320-0290

APPENDIX A
Claim 10

10. A dry electrostatographic developer composition comprising

(I) carrier particles, and

(II) a toner composition, comprising toner particles having a particle size distribution showing more than about 80% by volume of the toner particles with particle size diameter of less than about 10 µm and inorganic microparticles wherein:

(i) said microparticles are present in said toner composition in a concentration of at least 0.1 % by weight and at most 5% by weight with respect to the weight of toner particles

(ii) said microparticles being characterized by a product of BET surface (A) in $m^2/g$ times the methanol value (B) fulfilling the relation:

$$A \times B > 10{,}000$$

(iii) and the ratio of the apparent density over the bulk density of said toner composition satisfies the relation:

$$\frac{P_{app}}{P_{bulk}} \text{----\$ 0.2.}$$